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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,256	12/15/2003	Sheng-Ping Zhong	12013/59103	5800
26646	7590	01/25/2005	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			FULLER, ERIC B	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/737,256

Applicant(s)

ZHONG ET AL.

Examiner

Eric B Fuller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-43 and 47-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-43 and 47-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36-39, 41-42, 47, 49-50, and 52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castro et al. (US 6,395,326 B1) in view of Tisone (US 6,063,339).

Castro teaches coating a medical device substrate comprising placing the substrate in a holder assembly (column 8, line 29), placing a first agent into a first chamber connected to an inkjet printing head dispenser, delivering the first agent to the print head (column 8, lines 57-60), and moving the dispenser relative to the medical device in the x, y, and z directions to force the first agent onto the medical substrate in a desired pattern (column 16, line 12). Castro fails to explicitly teach that the print head is a "solenoid fluid dispensing head". However, Tisone teaches that solenoid valves used in print heads are beneficial in that they increase the precision of controlling the amount in each drop that is deposited (column 6, line 30 - column 7, line 17). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a solenoid valve in the process taught by Castro. By doing so, one would reap the benefits of increasing the precision of the coating.

Additionally, since Tisone teaches that solenoids are conventional to the art (column 2, lines 54-65), one would have a reasonable expectation of success. The combination of the two references would have been obvious, as Tisone teaches the art recognized suitability of using solenoid valves in print heads.

All other limitations are taught, or made obvious, by the references as shown in the previous Office Action.

Claims 40, 43, 48 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castro et al. (US 6,395,326 B1) in view of Tisone (US 6,063,339), as applied to claims above, and further in view of Hossainy et al. (US 6,287,628 B1).

Castro teaches the use of therapeutics on the substrate, but fails to explicitly teach radiopaque agents. However, Hossainy teaches that radiopaque agents are therapeutic, allowing for location to be accessed by X-ray, and groups them with other therapeutic agents taught by Castro. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use radiopaque agents in the process taught by Castro. By doing so, one would have a reasonable expectation of success, as Hossainy teaches the art recognized suitability of using such agents. Additionally, one would reap the benefits of enabling one to locate the implanted device upon X-ray. This additionally reads on communicating information to the exterior of the body.

Terminal Disclaimer

The terminal disclaimer filed on November 3, 2004 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of U.S. Patent 6,682,771 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

Applicant argues the motivation for combining Castro with Tisone. This argument is not found convincing. It has been shown above that a clear advantage is taught by Tisone teaches for using a solenoid valve. Additionally, Tisone establishes the art recognized suitability for using such a valve. Therefore, motivation for the combination exists and is sufficient.

Applicant argues the motivation for combining Castro and Tisone with Hossainy. This argument is not found convincing. It has been shown above that a clear advantage is taught by Hossainy teaches for using a radiopaque agent. Additionally, Hossainy establishes the art recognized suitability for using such an agent. Therefore, motivation for the combination exists and is sufficient.

All other arguments are moot in view of the new grounds of rejection, which were necessitated by the applicant's amendments.

Conclusion

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B Fuller whose telephone number is (571) 272-1420. The examiner can normally be reached on Mondays through Thursdays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck, can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



EBF



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